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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,348	04/14/2000	Anand Rangarajan	P3919	8679

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT PAPER NUMBER

2179

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,348

Applicant(s)

RANGARAJAN ET AL.

Examiner

Joshua D Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 5/18/2004
2. Claims 1-19 are pending in this case. Claims 1, 9, 15, and 19 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-6, 15-16, and 18-19 remain rejected under 35 U.S.C. 102(e) as being anticipated by Light et al. (hereinafter Light, US Patent Number 6,192,380, filed on March 31, 1998).

Regarding independent claim 1, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site (column 3, line 48-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light).

Regarding dependent claims 2-4, Light discloses a method in which forms are found on web pages on the Web (Internet) (column 1, lines 7-40 of Light).

Regarding dependent claim 5, Light discloses a method in which forms are filled out with information such as credit card numbers to pay for a service (Figure 6 and column 3, lines 5-59 of Light).

Regarding dependent claim 6, Light discloses a method in which the form-filling process is completely controlled by a single networked system (server) (Figure 3 and column 2, line 53-column 3, line 47 of Light).

Regarding independent claim 15, the claim incorporates substantially similar subject matter as claim 1. Thus the claim is rejected along the same rationale as claim 1.

Regarding dependent claim 16, the claim incorporates substantially similar subject matter as claims 2-4. Thus, the claim is rejected along the same rationale as claims 2-4.

Regarding dependent claim 18, Light discloses a method in which the system stores new form information obtained from a site once the form filling process is complete (column 4, lines 5-36 of Light).

Regarding independent claim 19, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site (column 3, line 48-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light discloses a method in which the system stores new form information obtained from a site once the form filling process is complete (column 4, lines 5-36 of Light).

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5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 7, 9-12, and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) as applied to claims 1 and 3 above, and further in view of Jacobs et al. (US Patent Number 5,611,048, issued on March 11, 1997).

Regarding dependent claim 7, Light does not disclose a method of distributing software functions over a plurality of server nodes. However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light

Regarding independent claim 9, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48-column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site (column 3, line 48-column 4, line 30). The fill-in unit then submits the

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data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light does not disclose a method of performing the functions using a server for each function.

However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light

Regarding dependent claims 10-12, the claims incorporate similar subject matter as claims 2-4. Thus, the claims are rejected along the same rationale as claims 2-4.

Regarding dependent claim 14, Light does not disclose a method of distributing software functions over a plurality of server nodes, which are connected to each other via a dedicated data network. However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers that are connected to each other via a local area network (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light

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7. Claims 8, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) as applied to claims 1, 3, 9, 10, and 15 above, and further in view of Kraft et al. (US Patent Number 6,084,585, with US filing date of December 5, 1997).

Regarding dependent claims 8, 13, and 17, Light does not disclose a method in which the job order is written in XML. However, Kraft et al. discloses that executable instructions which can be thought of as job orders can be written in any programming language including XML (column 3, lines 35-40 of Kraft et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Kraft et al. because the use of different programming languages was interchangeable.

Response to Arguments

8. Applicant's arguments filed 5/18/2004 have been fully considered but they are not persuasive.

Regarding the arguments presented on pages 8–11 in reference to independent claims 1, 9, 15, and 19, the transmission of an instruction and data contained within the instruction as disclosed by Light from the matching unit to the fill-in unit is of the nature of an executable instruction, executable by the fill-in unit. In addition to this the data necessary to navigate to and register for a site is incorporated in this transmission. As the claim is written the rejections the have been presented stand and have been clarified to incorporate the new limitations (see above).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

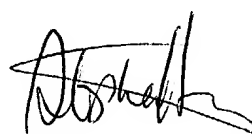
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
July 13, 2004



STEPHEN S. HONG
PRIMARY EXAMINER